

In response to the restriction requirement, applicant provisionally elects the claims of Group I (Claims 1-23 and 39-43) for examination with traverse. Applicant respectfully requests reconsideration of the restriction requirement with regard to Groups I and III for the reasons discussed below.

REMARKS

In the Office Action of September 23, 2004, a restriction requirement was imposed dividing the claims into three different groups. Specifically, the Office Action imposed a restriction requirement between the claims of Group I (Claims 1-23 and 39-43) drawn to a method for producing a colloidal dispersion of nanoparticles, Group II (Claims 24-29) drawn to a colloidal dispersion of nanoparticles, and Group III (Claims 30-38) drawn to an apparatus. Applicant respectfully traverses the restriction requirement with respect to Groups I and III.

According to MPEP § 803, two criteria must be met for a restriction requirement to be proper. First, the inventions must be independent or distinct as claimed. Second, a serious burden must be imposed on the Examiner. As stated in MPEP § 803, "if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicant respectfully submits that the close relationship between the subject matter of the claims in Groups I and III, at least, would allow all of the claims in those groups to be examined together without imposing any significant additional burden for either search or examination.

In the present case, the method claims of Group I and apparatus claims of Group III are so closely related that the pertinent art with respect to the method claims will also be the pertinent art for the apparatus claims. Therefore, the two sets of claims do not require a separate field of search. The extremely close relationship between the apparatus and method claims is illustrated by the fact that the structural elements recited in independent method claims 1 and 39 are also recited in independent apparatus claim 30.

Independent claims 1 and 39 are directed to methods for producing a colloidal dispersion of nanoparticles. The methods of claims 1 and 39 are carried out using an apparatus having three structural elements: 1) a reaction vessel for containing a dense fluid medium; 2) a rotatable first electrode (or a first electrode mounted for rotation); and 3) a second electrode near to the first electrode (or separated from the first electrode by a gap). Independent claim 30 is directed to a dense phase plasma discharge apparatus composed of the same three structural elements recited in claims 1 and 39, that is: 1) a chamber forming a reaction vessel for a dense medium; 2) a first electrode mounted for rotation in the chamber; and 3) a second electrode separated from the first electrode by a gap. Thus, based on the similarities between the structural elements in the apparatus and method claims, it follows that the pertinent prior art with respect to the method claims will also be the pertinent prior art with respect to the apparatus claims. Moreover, due to the similarities between the apparatus and method claims it is likely that the features that distinguish the methods of the present invention from the pertinent prior art references will be the same features that distinguish the apparatus of the present invention from those references. For these reasons, the search and examination of both sets of claims can be conducted without serious burden to the Examiner and Applicants respectfully request that the restriction requirement between Groups I and III be withdrawn.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the claims of Groups I and III may be examined together without placing a serious burden on the Examiner, and that appropriate reasons for insisting upon restriction of the claims have not been properly established. Thus, it is respectfully requested that the restriction requirement between the inventions of Groups I and III be withdrawn and that pending claims 1-23, 39-43 and 30-38 be examined together.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Michelle Manning', is written over a horizontal line.

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